

Attorney Docket No. 4409.214-US
Serial No. 09/772,607
Filed: January 30, 2001
Inventors: Jonassen et al.
Via Facsimile No.: 517-273-8300

REMARKS/ARGUMENTS

Claims 48-59 are pending in the present application.

REJECTION OF THE CLAIMS UNDER 35 U.S.C. 102

Claims 48-49 are rejected under section 102 (b) over Habener US Patent 5,118,666 ("the '666 patent") based on the Examiner's assertion (citing to US patent 5,466,458 or the '458 patent) that the reference in Habener to "lower alkyl" would be understood in the art to be C₁-C₈ or C₁-C₁₂.

Applicants respectfully traverse this rejection.

It is Applicants' position that since the cited Habener '666 patent states that "alkyl can be C₁-C₁₂" (col. 6, lines 25-26), it must logically follow that the use of "lower alkyl" in the '666 patent must mean something less than 12 carbons.

As to what is meant by the phrase "lower alkyl", Applicants submit that the '458 patent cited by the Examiner is not relevant to what one skilled in the art in the field of GLP-1 peptides would understand this phrase to mean as the '458 patent is directed to emulsified spray formulations of herbicides or pesticides.

Rather, it is Applicants' position that to understand what is meant by the phrase "lower alkyl" in the '666 patent, one skilled in the art would look to patents in the field of GLP-1 peptides. Applicants therefore direct the Examiner's attention to US patent 5,120,712 ("the '712 patent"), another patent on GLP-1 peptides by the inventor of the '666 patent (Habener). The '712 patent issued from an application filed on the same date (June 1, 1990) as the application that issued as the '666 patent and states that "lower alkyl" is C₁-C₆ (see col. 4, lines 21-25 of the '712 patent).

Further evidence that "lower alkyl" in the Habener '666 patent means C₁-C₆ alkyl to one skilled in the art in the field of GLP-1 peptides is provided by US patent 6,828,303 which

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describes the "lower alkyl" groups of the '666 and '712 patents as being C₁-C₆ alkyls (see col. 1, lines 55-67 of USP 6,828,303).

Accordingly, since "lower alkyl" in the Habener '666 patent means C₁-C₆ alkyl, Habener cannot be held to anticipate claims 48-49 of the present application and withdrawal of this refection is respectfully requested.